

REMARKS

The non-final Office Action mailed April 21, 2005, has been reviewed and carefully considered. Claims 1-29 are pending in the application. Claims 1-29 are rejected.

In paragraph two on page two of the Office Action, claims 1, 15, 18, 20, 24 and 25 were rejected under § 112, first paragraph. Claims 2-14, 16, 17, 19, 21-23, and 26-29 are rejected based on their dependency on the rejected independent claims.

In paragraph three on page three of the Office Action, claim 19 was rejected under § 112, first paragraph.

Applicant respectfully traverses the § 112, first paragraph rejection.

The determination of the propriety of a rejection based upon the scope of a claim relative to the scope of the enablement involves two stages of inquiry. The first is to determine how broad the claim is with respect to the disclosure. The entire claim must be considered. The second inquiry is to determine if one skilled in the art is enabled to make and use the entire scope of the claimed invention without undue experimentation. Moreover, Applicant respectfully submits that the Office Action's explanation on pages 12-13 fails to understand the operation of the the invention as well as the problem the inveniton overcomes. More specifically, Applicant's invention, as recited in the claims, does not involve print jobs that include font data that the printer cannot print.

Rather, as stated in the Applicant's specification on page 3, "it is not always clear wha the print server queue name is." More specifically, Applicant's identify the problem as bieng where the user does not know the queue name of the printer because the print job cannot be processed using standard protocols unless the queue name is provide. Thus, Applicant's invention eliminates the problem of precisely knowing the print queue name.

In order to eliminates the problem of precisely knowing the print queue name, Applicant's disclose a printer being associated with a print engine that receives print jobs via a plurality of print queues. According to the independent claims, if the user sends a print job having a print queue name that does not conform to queue names currently identified. As explained in Applicant's specification on page 13, lines 21-23, a job control module 302 manages the print queues 304. Further, as shown in Fig. 3, and

described on pages 13-14, each print queue, including the "residual print queue", has a print filter associated therewith. One task of the filter is to transfer the print jobs into a printer specific format. An administrator may select the filtering for the residual queue, see page 16, lines 7-8. Thus, the filtering that is needed to print a print job is a process that is understood in the art and may be implemented by an administrator. The scope of the invention does not involve novel selection of the filtering. While the filtering applied to the residual queue may be subject to further inventive effort to further improve printing, Applicant's invention, as disclosed in the specification and recited in the claims, eliminates the problem of precisely knowing the print queue name by providing a residual queue and well-known filtering for such print jobs.

Accordingly, one skilled in the art would recognize how to implement a printing system that includes residual queues for print jobs having an unrecognized print queue name and that thus eliminates the problem of precisely knowing the print queue name

With regard to the rejection of claim 19 under § 112, first paragraph, Applicant respectfully submits that the exact schemes for filtering print jobs is not within the scope of the present invention. As described above, one skilled in the art would recognize how to implement a printing system that includes residual queues for print jobs having an unrecognized print queue name and that thus eliminates the problem of precisely knowing the print queue name. Further, filtering for other print queues having recognized print queue names are also filtered using well-known filtering methodologies for such print jobs.

In view of the above explanation of Applicant's invention, and the problem addressed thereby, Applicant respectfully requests that the rejection of the claims under § 112, first paragraph be withdrawn.

In paragraph four on page three of the Office Action, claims 1-7, and 9-29 were rejected under § 103(a) as being unpatentable over Hower, Jr. et al. (US 5,467,434) in view of Yellepeddy et al. (US 6,288,790).

In paragraph five on page 11 of the Office Action, Claim 8 is rejected under § 103(a) as being unpatentable over Hower in view of Yellepeddy as applied to independent Claim 1 and dependent Claim 7 above, and further in view of McLaughlin.

Applicants respectfully traverse the 35 U.S.C. § 103(a) rejections. Applicant's independent claims require at least "receiving print jobs; forwarding print jobs having a print queue designation that matches a named print queue in the printing device to the designated print queue; forwarding print jobs having a print queue designation that does not match a named print queue in the printing device to the residual print queue; and printing a print job forwarded to the residual print queue."

In contrast, Hower, Jr. et al. disclose a method for determining printer option availability, wherein a plurality of printers each have separate printer profiles. However, as indicated in the Office Action, Hower, Jr. et al. do not disclose the idea of a residual queue to handle print jobs having unrecognized print queue names.

Yellepeddy fails to overcome the deficiencies of Hower, Jr. et al. Yellepeddy discloses a mobile support facility for printing. Yellepeddy discloses that a local transient printer queue is automatically created and all print jobs submitted by the client data processing system are spooled to the transient printer queue when a client data processing system is disconnected from a desired remote print server, or the remote print server is otherwise inaccessible.

However, according to Yellepeddy, the transient print queue receives print jobs that have designations that match a print queue that is disconnected or otherwise unavailable.

Thus, Yellepeddy fails to disclose, teach or suggest at least "forwarding print jobs having a print queue designation that does not match a named print queue in the printing device to the residual print queue."

Accordingly, Hower, Jr. et al. and Yellepeddy alone or in combination, fail to disclose, teach or suggest all of the limitations of Applicants' application. Thus, Applicants assert that the § 103(a) rejections are improper and request that the rejections be withdrawn.

McLaughlin fails to overcome the deficiencies of Hower, Jr. et al. and Yellepeddy. McLaughlin is merely cited as teaching the use of the Line Printer Daemon (LPD) protocol. McLaughlin fails to even mention the problem of print jobs having unrecognized print queue names. Thus, Hower, Jr. et al., Yellepeddy and McLaughlin,

alone or in combination, fail to disclose, teach or suggest all of the limitations of Applicants' application. Thus, Applicants assert that the § 103(a) rejections are improper and request that the rejections be withdrawn.

Dependent claims 2-14, 16-17, 19, 21-23, and 26-29 are also patentable over the references, because they incorporate all of the limitations of the corresponding independent claims 1, 15, 18, 20 and 25. Further dependent claims 2-14, 16-17, 19, 21-23, and 26-29 recite additional novel elements and limitations. Applicants reserve the right to argue independently the patentability of these additional novel aspects. Therefore, Applicants respectfully submit that dependent claims 2-14, 16-17, 19, 21-23, and 26-29 are patentable over the cited references, and request that the objections to the independent claims be withdrawn.

Furthermore, Hower, Jr. et al. teaches away from Applicant's invention.

Hower, Jr. et al. disclose a decision tree that is used to compare parameters of printers to print job selections and matching printers with print jobs. However, when a print job requires unprogrammed print properties, none of the available printers are capable of printing the print job. *See* column 7.

Yellepeddy assumes that print jobs in the transient print queue are capable of being printed by a printer facility in the network. This is in contrast to Hower, Jr. et al., where due to the nature of print job parameters associated with a print job, the print job is not capable of being printed by any printer. Thus, combining Yellepeddy with Hower, Jr. et al. would require the decision tree of Hower, Jr. et al. to be changed, thereby changing the principle of operation of Hower, Jr. et al.

According to MPEP § 2143.01, "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." When a user selects an impermissible combination of print selections that have not been programmed in Hower, a fault message is communicated to the user. *See* column 7, lines 37-41.

Accordingly, the combination of Hower and Yellepeddy is improper. Thus, Applicants assert that the § 103(a) rejections are improper and request that the rejections be withdrawn.

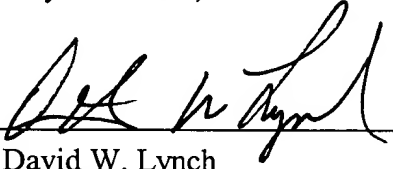
On the basis of the above amendments and remarks, it is respectfully submitted that the claims are in immediate condition for allowance. Accordingly, reconsideration of this application and its allowance are requested.

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If a telephone conference would be helpful in resolving any issues concerning this communication, please contact Attorney for Applicants, David W. Lynch, at 651-686-6633 Ext. 116.

CRAWFORD MAUNU PLLC
1270 Northland Drive, Suite 390
Saint Paul, MN 55120
(651) 686-6633

Respectfully submitted,

By: 
Name: David W. Lynch
Reg. No.: 36,204